IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: William Wadleigh   Examiner: Paul D'Agostino

Serial No.:   10/659,581   Group Art Unit: 3714

Filed: September 9, 2003   Docket: 1842.002US1

Title: ELECTRONIC GAME AND SYSTEM HAVING OVERLAYED VIDEO
              IMAGES

PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR 1.181

MS PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

A Notice of Abandonment mailed April 16, 2008 for the above-identified patent application was received by our office. The Notice alleges that Applicant failed to timely file a proper reply to the final Office Action mailed September 20, 2007 by the six-month response deadline of March 20, 2008.

Applicant respectfully disagrees. Applicant filed a Request for Continued Examination along with a Response to the final Office Action and a petition for a three-month extension of time on March 20, 2008, with a signed Certificate of Mailing reflecting the same. In return, Applicant received a PTO-stamped postcard acknowledging receipt of the submitted response by the USPTO. Additionally, Applicant notes that the Response to the Office Action mailed on March 20, 2008 is uploaded and available for examination in the USPTO's Patent Application Information Retrieval (PAIR) system.

True and accurate copies of the documents mailed March 20, 2008, along with a copy of the PTO-stamped postcard are enclosed. Therefore, Applicant submits that the response was timely filed and respectfully requests reconsideration of the holding of abandonment.

It is believed that there is no action or omission by Applicant to support a holding that the above-identified application was or is abandoned. Accordingly, it is respectfully requested that the abandonment holding be withdrawn and prosecution resumed as soon as possible.

Petition to Withdraw Holding of Abandonment
Serial Number: 10/659,581
Filing Date: September 9, 2003
Title: ELECTRONIC GAME AND SYSTEM HAVING OVERLAYED VIDEO IMAGES
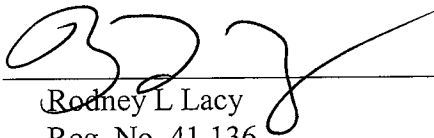
Page 2
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CONCLUSION

It is Applicant's understanding that no fee is required for a petition to withdraw a holding of abandonment; *see* MPEP 711.03(c), and therefore no fee is enclosed. However, if a fee is required, please charge it to Deposit Account No. 19-0743.

The Examiner is invited to telephone Applicant's attorney at 612-371-2103 to facilitate prosecution of this application.
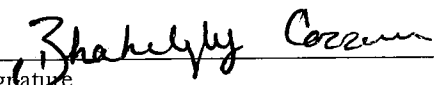
Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

Date _Jun 16 2008_ By _____
Rodney L Lacy
Reg. No. 41,136

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16 day of June, 2008.

Zhakalazky M. Carrion
_____
Name

_____
Signature

REQUEST **FOR** **CONTINUED EXAMINATION (RCE)** **TRANSMITTAL** Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000, provides for continued examination of an utility or plant application filed on or after June 8, 1995. See The American Inventors Protection Act of 1999 (AIPA).	*Application Number*	10/659,581
	Filing Date	September 9, 2003
	First Named Inventor	William Wadleigh
	Group Art Unit	3714
	Examiner Name	Alan Cross
	Attorney Docket Number	1842.002US1
	Customer No.	70648

This is a Request for Continued Examination (RCE) under 37 CFR § 1.114 of the above-identified application entitled ELECTRONIC GAME AND SYSTEM HAVING OVERLAYED VIDEO IMAGES.
Submission required under 37 C.F.R. § 1.114

1. __   Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on .

2. __   Consider the arguments in the Appeal Brief or Reply Brief previously filed on .

3. X   Amendment Under 37 CFR § 1.116 (_19_ pages) is enclosed.

4. __   New power of attorney (pages) is enclosed.

5. __   Information Disclosure Statement is enclosed (pages), with:
   a.   Form 1449 (_pages)
   b.   Copies of IDS Citations ()

6. X   Please charge Deposit Account 19-0743 in the amount of $810.00 to pay the RCE filing fee required under C.F.R. § 1.17(e).

7. X   **The Commissioner is hereby authorized to credit overpayments or charge any fees set forth in 37 CFR §§ 1.16 through 1.18 to Deposit Account No. 19-0743.**

8. X   Petition for Extension of Time in the prior application (1 page) is enclosed along with authorization to charge Deposit Account 19-0743 in the amount of $1050.00 to pay the extension fee.

9. __   Others:

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.

By _____
Atty: Rodney L. Lacy
Reg. No. 41,136

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of March 2008.

_____
Name

_____
Signature

COPY

S/N 10/659,581   PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: William Wadleigh   Examiner: Alan Cross
Serial No.: 10/659,581   Group Art Unit: 3714
Filed: September 9, 2003   Docket No: 1842.002US1
Title   ELECTRONIC GAME AND SYSTEM HAVING OVERLAYED VIDEO
             IMAGES

PETITION FOR A THREE-MONTH EXTENSION OF TIME

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with the provision of 37 CFR § 1.136(a), it is respectfully requested that a

three-month extension of time be granted in which to respond to the Final Office Action mailed

September 20, 2007, said period of response being extended from December 20, 2007 to March

20, 2008.

Please charge Deposit Account No. 19-0743 in the amount of $1050.00 to cover the

required extension fee. Please charge any additional fees or credit overpayment to deposit

Account No. 19-0743.

Respectfully Submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

Date: March 20, 2008   By: _____
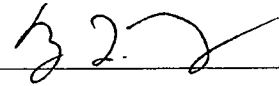   Rodney L. Lacy
                                  Reg. No: 41,136

CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of March 2008.

Name: _____   Signature: _____

EXPEDITED PROCEDURE – EXAMINING GROUP 3714

<u>S/N 10/659,581</u>   **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	William Wadleigh	Examiner: Alan Cross	
Serial No.:	10/659,581	Group Art Unit: 3714	
Filed:	September 9, 2003	Docket No.: 1842.002US1	
Title:	ELECTRONIC GAME AND SYSTEM HAVING OVERLAYED VIDEO IMAGES		

AMENDMENT & RESPONSE UNDER 37 C.F.R. 1.116

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action mailed <u>September 20, 2008,</u> please amend the application as follows:

This response is accompanied by a Petition, as well as the appropriate fee, to obtain a 3-month extension of the period for responding to the Office action, thereby moving the deadline for response from December 20, 2007 to March 20, 2008.

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IN THE CLAIMS

Please amend the claims as follows.

1.   (Currently Amended) A method comprising:

displaying a supplemental graphical element over at least one symbol element in one or more displayed reels of a casino gaming machine, the displaying including overlaying <u>in a memory storing video data</u> pixel values of the at least one symbol element with pixel values of the supplemental graphical element, wherein <u>each of</u> the at least one symbol element that <u>is overlaid</u> remains at least partially visible while the supplemental graphical element is displayed.

2.   (Original) The method of claim 1, further comprising:

displaying the at least one symbol element;

determining, based on the at least one symbol element, whether a triggering event has occurred; and

if a triggering event has occurred, identifying the supplemental graphical element as a set of video images.

3.   (Original) The method of claim 1, wherein displaying the supplemental graphical element comprises displaying the supplemental graphical element in a manner that creates an appearance of full motion video.

4.   (Currently Amended) A method comprising:

displaying <u>on a video display</u> at least a portion of a reel symbol element during a play iteration of a casino game; and

in conjunction with the display of the reel symbol element, and before the play iteration is completed, displaying a supplemental graphical element so that it appears as an overlay over the reel symbol element, the displaying including overlaying<u>, in a memory storing video data,</u> pixel values of the ~~at least one~~ reel symbol element with pixel values of the supplemental graphical element, wherein the reel symbol element appears to be at least partially visible during at least a portion of a time period that the supplemental graphical element is displayed.

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5.   (Original) The method of claim 4, further comprising:

determining, based on the at least one symbol elements, whether a triggering event has occurred; and

if a triggering event has occurred, identifying the supplemental graphical element as a set of video images.

6.   (Currently Amended) The method of claim 4, wherein displaying the supplemental graphical element comprises displaying the supplemental graphical element in a manner that creates an appearance of full motion video ~~overlayed~~ overlaid over the reel symbol element.

7.   (Currently Amended) An apparatus comprising:

one or more processors, which

cause multiple game element images to be displayed within multiple game element areas of a video display device,

determine based on the multiple game element images, whether a triggering event has occurred,

if a triggering event has occurred, identify a set of video images, and

cause the set of video images to be displayed on the video display device in conjunction with the multiple game element images, so that the set of video images appears as an overlay over one or more of the multiple game element images;

wherein each of the one or more of the multiple game element images that are overlaid appear to be at least partially visible during at least a portion of a time period that the set of video images is displayed.

8.   (Original) The apparatus of claim 7, wherein the one or more processors causes the set of video images to be displayed in a manner that creates an appearance of full motion video.

9.   (Canceled)

10.   (Currently Amended) The apparatus of claim 7, wherein the one or more processors causes the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as an opaque overlay over each of the one or more of the multiple game element images that are overlaid.

11.   (Currently Amended) The apparatus of claim 7, wherein the one or more processors causes the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as semi-transparent overlay over each of the one or more of the multiple game element images that are overlaid.

12.   (Original) The apparatus of claim 7, wherein the one or more processors further:
          determines whether a video image is associated with an alteration of a game element image within a game element area; and
          if the video image is associated with the alteration, causes an altered image to be displayed in the game element area.

13.   (Currently Amended) The apparatus of claim 7, wherein the apparatus forms a portion of a wagering game machine, and the apparatus further comprises:
          a display device, operatively coupled to the one or more processors.

14.   (Currently Amended) The apparatus of claim 7, wherein the apparatus forms a portion of a portable, battery powered video game system, and the apparatus further comprises:
          a display device, operatively coupled to the one or more processors.

15.   (Currently Amended) The apparatus of claim 7, wherein the apparatus forms a portion of a personal computer, and the apparatus further comprises:
          a display device, operatively coupled to the one or more processors.

16.   (Original) The apparatus of claim 7, wherein the apparatus forms a portion of a video game system that interacts with a television set, and causing the set of video images to be displayed comprises causing the set of video images to be displayed on the television set.

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17.   (Currently Amended) An electronic slot machine comprising:

at least one memory to store video data for multiple symbol images and video images;

one or more processors, which

cause the multiple symbol images to be displayed, by one or more video display devices, within multiple symbol areas associated with multiple reels,

determine based on the multiple symbol images, whether a triggering event has occurred,

if a triggering event has occurred, identify a set of video images, and cause the set of video images to be displayed in conjunction with the multiple symbol images by overlaying pixel values of one or more of the multiple symbol images with pixel values of the set of video images, so that the set of video images appears as an overlay over each of the one or more of the one or more multiple symbol images that are overlaid, wherein a portion of a video image within the set is displayed within a first set of pixels within a symbol area, such that a symbol image associated with the symbol area of each of the one or more symbol images that are overlaid is at least partially visible; and

one or more display devices, operatively coupled to the one or more processors, which display the multiple symbol images and the set of video images.

18.   (Original) The electronic slot machine of claim 17, wherein the one or more processors causes the set of video images to be displayed in a manner that creates an appearance of full motion video.

19.   (Canceled)

20.   (Currently Amended) The electronic slot machine of claim 17, wherein the one or more processors cause the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as an opaque overlay over each of the one or more of the multiple symbol images that are overlaid.

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21.   (Currently Amended) The electronic slot machine of claim 17, wherein the one or more

processors cause the set of video images to be displayed by causing the set of video images to be

displayed in a manner that the set of video images appears as semi-transparent overlay over each

of the one or more of the multiple symbol images that are overlaid.

22.   (Original) The electronic slot machine of claim 17, wherein the one or more processors

further:

determine whether a video image is associated with an alteration of a symbol image

within a symbol area; and

if the video image is associated with the alteration, cause an altered image to be displayed

in the symbol area.

23.   (Original) The electronic slot machine of claim 17, further comprising:

a money/credit input/output (I/O) device for enabling a player to obtain credits; and

player input devices that enable the player to specify a bet and to initiate a spin of the

multiple reels.

24.   (Currently Amended) A method for displaying images in an electronic game, the method

comprising:

causing multiple game element images to be displayed within multiple game element

areas of a video display;

determining based on the multiple game element images, whether a triggering event has

occurred;

if a triggering event has occurred, identifying a set of video images; and

causing the set of video images to be displayed in conjunction with the multiple game

element images by overlaying pixel values of one or more of the multiple game element images

with pixel values of the set of video images, so that the set of video images appears as an overlay

over each of the one or more of the multiple game element images that are overlaid, such that

each of the one or more of the game element image images that are overlaid is at least partially

visible.

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25.   (Original) The method of claim 24, wherein causing the set of video images to be displayed comprises causing the set of video images to be displayed in a manner that creates an appearance of full motion video.

26.   (Canceled)

27.   (Currently Amended) The method of claim 24, wherein causing the set of video images to be displayed comprises:

      causing the set of video images to be displayed in a manner that the set of video images appears as an opaque overlay over each of the one or more of the multiple game element images that are overlaid.

28.   (Currently Amended) The method of claim 24, wherein causing the set of video images to be displayed comprises:

      causing the set of video images to be displayed in a manner that the set of video images appears as semi-transparent overlay over each of the one or more of the multiple game element images that are overlaid.

29.   (Original) The method of claim 24, further comprising:

      determining whether a video image is associated with an alteration of a game element image within a game element area; and

      if the video image is associated with the alteration, causing an altered image to be displayed in the game element area.

30.   (Currently Amended) The method of claim 24, wherein the electronic game is a game designed for execution on a wagering game machine, and causing the set of video images to be displayed comprises causing the set of video images to be displayed on a video display device coupled to the wagering game machine.

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31.   (Original) The method of claim 30, wherein the electronic game is an electronic slot machine game, and the multiple game elements include multiple symbol areas, and the multiple game element images includes multiple symbols displayed within the multiple symbol areas.

32.   (Currently Amended) A method for displaying images in an electronic slot machine game, the method comprising:

causing multiple symbol images to be displayed on a video display within multiple symbol areas associated with multiple reels;

determining based on the multiple symbol images, whether a triggering event has occurred;

if a triggering event has occurred, identifying a set of video images; and

causing the set of video images to be displayed in conjunction with the multiple symbol images by overlaying pixel values of the multiple symbol images with pixel values of the set of video images, so that the set of video images appears as an overlay over each of one or more of the multiple symbol images that are overlaid, wherein the set of video images are displayed such that a symbol image associated with the symbol area of each of the one or more of the multiple symbol images that are overlaid is at least partially visible.

33.   (Original) The method of claim 32, wherein causing the set of video images to be displayed comprises causing the set of video images to be displayed in a manner that creates an appearance of full motion video.

34.   (Canceled)

35.   (Currently Amended) The method of claim 32, wherein causing the set of video images to be displayed comprises:

causing the set of video images to be displayed in a manner that the set of video images appears as an opaque overlay over each of the one or more of the multiple symbol images that are overlaid.

36.　　(Currently Amended) The method of claim 32, wherein causing the set of video images to be displayed comprises:

causing the set of video images to be displayed in a manner that the set of video images appears as semi-transparent overlay over each of the one or more of the multiple symbol images that are overlaid.

37.　　(Original) The method of claim 32, further comprising:

determining whether a video image is associated with an alteration of a symbol image within a symbol area; and

if the video image is associated with the alteration, causing an altered image to be displayed in the symbol area.

38.　　(Currently Amended) A computer-readable medium having program instructions stored thereon to perform a method, which when executed within an apparatus, result in:

causing multiple game element images to be displayed within multiple game element areas on a video display;

determining based on the multiple game element images, whether a triggering event has occurred;

if a triggering event has occurred, identifying a set of video images; and

causing the set of video images to be displayed in conjunction with the multiple game element images by overlaying pixel values of the multiple game element images with pixel values of the set of video images, so that the set of video images appears as an overlay over each of one or more of the multiple game element images that are overlaid, such that each of the one or more of the game element images that are overlaid is at least partially visible.

39.　　(Original) The computer-readable medium of claim 38, wherein causing the set of video images to be displayed comprises causing the set of video images to be displayed in a manner that creates an appearance of full motion video.

40.　　(Canceled)

41.   (Currently Amended) The computer-readable medium of claim 38, wherein causing the set of video images to be displayed comprises:

causing the set of video images to be displayed in a manner that the set of video images appears as an opaque overlay over each of one or more of the multiple game element images that are overlaid.

42.   (Currently Amended) The computer-readable medium of claim 38, wherein causing the set of video images to be displayed comprises:

causing the set of video images to be displayed in a manner that the set of video images appears as semi-transparent overlay over each of the one or more of the multiple game element images that are overlaid.

43.   (Original) The computer-readable medium of claim 38, executing the program instructions further result in:

determining whether a video image is associated with an alteration of a game element image within a game element area; and

if the video image is associated with the alteration, causing an altered image to be displayed in the game element area.

44.   (Currently Amended) A casino game comprising:

at least one memory for storing a supplemental graphic element and data for symbol elements;

a video display; and

a computer-readable medium having program instructions stored thereon to perform a method, which when executed within the casino game, result in:

the display displaying [[a]] the supplemental graphical element over at least one symbol element of the symbol elements in one or more displayed reels of the casino game, wherein the method includes overlaying pixel values of the at least one symbol element with pixel values of the supplemental graphical element and further wherein each of the at least one symbol element that is overlaid remains at least partially visible while

the supplemental graphical element is displayed.

45.   (Original) The casino game of claim 44, wherein executing the program instructions further results in:

the display displaying the at least one symbol element;

determining, based on the at least one symbol element, whether a triggering event has occurred; and

if a triggering event has occurred, identifying the supplemental graphical element as a set of video images.

46.   (Original) The casino game of claim 44, wherein displaying the supplemental graphical element comprises displaying the supplemental graphical element in a manner that creates an appearance of full motion video.

47.   (Currently Amended) An apparatus comprising:

processing means for

causing multiple game element images to be displayed within multiple game element areas of a video display device,

determining based on the multiple game element images, whether a triggering event has occurred,

if a triggering event has occurred, identifying a set of video images, and

causing the set of video images to be displayed on the video display device in conjunction with the multiple game element images, so that the set of video images appears as an overlay over one or more of the multiple game element images, such that each of the one or more of the game element images that are overlaid is at least partially visible.

48.   (Original) The apparatus of claim 47, wherein the processing means causes the set of video images to be displayed in a manner that creates an appearance of full motion video.

49.   (Canceled)

50.   (Currently Amended) The apparatus of claim 47, wherein the processing means causes the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as an opaque overlay over each of one or more of the multiple game element images that are overlaid.

51.   (Currently Amended) The apparatus of claim 47, wherein the processing means causes the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as semi-transparent overlay over each of the one or more of the multiple game element images that are overlaid.

52.   (Original) The apparatus of claim 47, wherein the processing means further:
        determines whether a video image is associated with an alteration of a game element image within a game element area; and
        if the video image is associated with the alteration, causes an altered image to be displayed in the game element area.

53.   (New) The method of claim 1, wherein displaying the supplemental graphical element includes displaying the supplemental graphical element within a boundary determined by a component of the supplemental graphical element.

54.   (New) The method of claim 4, wherein displaying the supplemental graphical element includes displaying the supplemental graphical element within a boundary determined by a component of the supplemental graphical element.

55.   (New) The apparatus of claim 7, wherein the set of video images are displayed within a boundary determined by a component within an image of the set of video images.

56.   (New) The method of claim 24, wherein causing the set of video images to be displayed includes displaying the set of video images within a boundary determined by a component within an image of the set of video images and wherein the boundary changes from a first image of the

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set of video images to a second image of the set of video images, the boundary changing in accordance with changes in the component.

57.   (New) The computer-readable medium of claim 38, wherein causing the set of video images to be displayed includes displaying the set of video images within a boundary determined by a component within an image of the set of video images.

58.   (New) The apparatus of claim 47, wherein the processing means causes the set of video images to be displayed within a boundary determined by a component within an image of the set of video images.

REMARKS

This responds to the Office Action mailed on <u>September 20, 2008</u>.

Claims 1, 4, 6-7, 10-11, 13-15, 17, 20-21, 24, 27-28, 30, 32, 35-36, 38, 41-42, 44, 47 and 50-51 are amended, no claims are canceled in this response, claims 9, 19, 26, 34, 40 and 49 were previously canceled, and claims 53-58 are added; as a result, claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48 and 50-58 are now pending in this application.

Double Patenting Rejection

Claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48 and 50 were rejected under a non-statutory double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,517,433 to Loose (Loose) of record in view of U.S. Patent No. 6,375,570 to Poole (Poole) of record and U.S. Patent 6,270,411 to Gura et al. (Gura) of record.

Applicant does not admit that the currently pending claims are obvious in view of U.S. Patent No. 6,517,433 to Loose (Loose) of record in view of Loose, Poole and Gura. However, Applicant will consider filing a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv) when all other issues related to the patentability of the claims have been resolved.

§103 Rejection of the Claims

Claims 1-8, 10-13, 17-18, 20-25, 27-33, 35-39, 41-48 and 50-52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,517,433 to Loose of record in view of U.S. Patent 6,270,411 to Gura of record.

Claims 1-8, 10-13, 17-18, 20-25, 27-33, 35-39, 41-48 and 50-52 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,375,570 to Poole of record in view of U.S. Patent 6,270,411 to Gura of record.

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in

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Graham are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

The test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). Moreover, "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006). This was recently echoed by the U.S. Supreme Court in *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.).

Independent claims 1, 4, 7, 17, 24, 32, 38, 44 and 47 have been amended to clarify that the game elements are video images that are overlaid by other video images. Thus the

overlaying and overlaid images comprise video data. Further, each of the independent claims have been amended to clarify that each image that is overlaid remains at least partially visible after the overlaying of the video data. For example, claim 1 as amended recites "overlaying in a memory storing video data pixel values of the at least one symbol element with pixel values of the supplemental graphical element, wherein each of the at least one symbol element that is overlaid remains at least partially visible while the supplemental graphical element is displayed." Each of the independent claims has been amended to recite language similar to the amendment shown above for claim 1. Applicant respectfully submits that no combination of Loose, Poole or Gura discloses overlaying video data with other video data such that the overlaid symbol or gaming element remains at least partially visible. In Loose, the game symbols or elements are not video data. Rather the game symbols comprise mechanical reels (see e.g., Abstract). Thus there is no overlaying in a video memory of game elements or symbols with video data such that the overlaid symbols remain partially visible.

In Gura, there are game elements that do not remain partially visible. For example, the video illustrated in Figs. 10 and 11 shows that the center symbol of the center reel is totally covered by the video display, and therefore does not remain partially visible. Gura does not teach or suggest that each symbol that is overlaid remains at least partially visible.

Similarly, in Poole, the video data completely covers one or more symbols. For example, Poole's Fig. 5 illustrates that the center video reels are completely covered such that no overlaid game element remains partially visible. Poole does not teach or suggest that game elements or symbols are overlaid such that each overlaid element or symbol remains at least partially visible.

Thus in view of the above, none of Loose, Poole or Gura, alone or in combination, discloses overlaying game element or symbol video data with supplemental video data such that each game element or symbol that is overlaid remains at least partially visible. Therefore no combination of Loose, Poole or Gura discloses each and every element of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47. As a result, claims 1, 4, 7, 17, 24, 32, 38, 44 and 47 are nonobvious because there are differences between the cited references and Applicant's claims. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 4, 7, 17, 24, 32, 38, 44 and 47.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
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Each of dependent claims 2-3, 5-6, 8, 10-16, 18, 20-23, 25, 27-31, 33, 35-37, 39, 41-43, 45-46, 48 and 50-52 depends from an independent claim and is therefore allowable for at least the reasons discussed above regarding their respective independent base claims. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is also nonobvious. MPEP § 2143.03.

New Claims 53-58

Claims 53-58 have been added in this response. Support for claims 53-58 may be found throughout the specification and at least on pages 10 and 13 of the specification. Applicant believes that no new matter has been introduced in new claims 53-58.

Claims 53-58 depend from claims 1, 4, 7, 24, 38 and 47 respectively. Claims 53-58 are therefore allowable for at least the reasons discussed above regarding their respective base claims. Additionally, each of claims 53-58 recites that the boundary of a supplemental graphical element or set of video images that provide the overlay is determined by a component of the image itself. For example, a video image containing a character that is to be used as an overlay may have an overlay boundary determined by the boundary of the character. Applicant has reviewed Loose, Poole and Gura, and can find no teaching or suggestion of using a boundary of a component within an image to determine the boundary of an overlay image. As a result, new claims 53-58 recite elements that are not found in any combination of Loose, Poole and Gura and are therefore allowable.

Further, claim 56 recites that the boundary of image overlaying a game element may change from image to image in a set of video image, where the boundary change corresponds to a change in the boundary of a component within the set of video images. For example, if a character moves in the set of video images, then the boundary of the overlaying images changes as the character moves. None of Loose, Poole or Gura teaches or suggests that the boundary of an overlaying image may change in the manner recited in claim 56.

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Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

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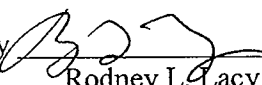
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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
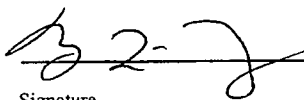P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

Date March 20, 2008

By _____
Rodney L. Lacy
Reg. No. 41,136

CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of March 2008.

Rodney L. Lacy
_____
Name

_____
Signature

Receipt is hereby acknowledged for the following in the United States Patent and Trademark Office:

In re Patent Application of: William Wadleigh

Title: ELECTRONIC GAME AND SYSTEM HAVING OVERLAYED VIDEO IMAGES

Serial No.: 10/659,581   Filing Date: September 9, 2003

CONTENTS: Amendment and Response (_19_ pgs.); Petition for Extension of Time (1 pg.); including authorization to charge Deposit Account No. 19-0743 in the amount of $1050.00 to cover the Extension of Time Fee, return postcard and transmittal sheet.

Mailed: March _20_ , 2008   Docket No.: 1842.002US1
RLL/   Due Date: March 20, 2008

Receipt is hereby acknowledged for the following in the United States Patent and
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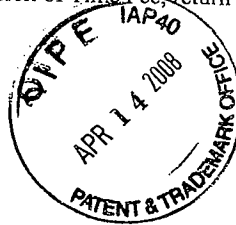In re Patent Application of: William Wadleigh
Title: ELECTRONIC GAME AND SYSTEM HAVING OVERLAYED VIDEO
            IMAGES
Serial No.: 10/659,581

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